

1614

USPTO 10/13/2006 3:58:31 PM PAGE 1/005 Fax Server  
TO:Dorethea Lawrence COMPANY:

Rec'd PCT/PTO 13 OCT 2006



## UNITED STATES PATENT AND TRADEMARK OFFICE

### Facsimile Transmission

To: Name: Dorethea Lawrence  
Company:  
Fax Number: (571) 273-3201  
Voice Phone:

From: Name:  
Voice Phone:

37 C.F.R. 1.6 sets forth the types of correspondence that can be communicated to the Patent and Trademark Office via facsimile transmissions. Applicants are advised to use the certificate of facsimile transmission procedures when submitting a reply to a non-final or final Office action by facsimile (37 CFR 1.8(a)).

Fax Notes:

---

---

Date and time of transmission: Friday, October 13, 2006 3:58:22 PM  
Number of pages including this cover sheet: 05

---



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants: Szelenyi et al. Examiner: Brian Kwon  
Serial No.: 10/727,658 Art Unit: 1614  
Filed: December 5, 2003 Docket: 6319-1815 (formerly 034082-001)  
Title: Combinations of Potassium Channel Openers and Sodium Channel Inhibitors or Sodium Channel -Influencing Active Compounds for Treating Pains

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

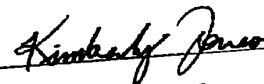
**REPLACEMENT TERMINAL DISCLAIMER**  
**TRANSMITTAL**

Sir:

As requested by the Examiner in a telephone call to the undersigned on July 24, 2006, enclosed herewith is a terminal disclaimer that replaces the terminal disclaimer which was filed April 3, 2006, in a response to the Office Action dated November 2, 2005. Applicants respectfully request that the enclosed terminal disclaimer be made of record in this application.

If additional fees are due, Applicants authorize the Commissioner to deduct said fees from deposit account number 02-4270.

**Certificate of Mailing:** I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First-Class Mail addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on August 4, 2006.

  
\_\_\_\_\_  
Kimberly Jones  
Printed Name

8/4/06  
Date

BRMFS1 935512v.1

USPTO  
TO: Dorethea Lawrence COMPANY:  
10/13/2006 3:58:31 PM PAGE 3/005 Fax Server

Respectfully submitted,

Dated: 4 Aug 2006

Heidi Reese  
Heidi Reese  
Reg. No. 57,841  
BROWN RAYSMAN MILLSTEIN FELDER  
& STEINER LLP  
900 Third Avenue  
New York, New York 10022  
(212) 895-2000

BRMFS1 935512v.1

USPTO  
TO: Dorethea Lawrence COMPANY:

10/13/2006 3:58:31 PM

PAGE

4/005

Fax Server



PTO/SB/25 (10-05)  
Approved for use through 07/31/2006. OMB 0651-0031  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

**TERMINAL DISCLAIMER TO OBTAIN A PROVISIONAL DOUBLE PATENTING  
REJECTION OVER A PENDING "REFERENCE" APPLICATION**

Docket Number (Optional)  
6319-1815

In re Application of: SZELENYI et al.

Application No.: 10/727,858

Filed: December 5, 2003

For: VALEANT PHARMACEUTICALS INTERNATIONAL

The owner, VALEANT PHARMACEUTICALS INTERNATIONAL, of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending reference Application Number 10/727,658 filed on December 5, 2003, as such term is defined in 35 U.S.C. 154 and 173, and as the term of any patent granted on said reference application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending reference application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the reference application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of any patent granted on said reference application, "as the term of any patent granted on said reference application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending reference application." In the event that any such patent granted on the pending reference application expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record. Reg. No. 57,841

*Heldi Reese*  
Signature

4 AUGUST 2006  
Date

Heldi Reese  
Typed or printed name

212-895-2424  
Telephone Number

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

\*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).  
Form PTO/SB/98 may be used for making this statement. See MPEP § 324.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

USPTO  
TO: Dorethea Lawrence COMPANY:

10/13/2006 3:58:31 PM PAGE 5/005 Fax Server



Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.  
PTO/SB/06 (09-04)  
Approved for use through 07/31/2006. OMB 0651-0031  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

**STATEMENT UNDER 37 CFR 3.73(b)**

Applicant/Patent Owner: Valeant Pharmaceuticals North America (formerly known as Xcel Pharmaceuticals, Inc.)  
Application No./Patent No.: 10/727,658 Filed/Issue Date: December 5, 2003  
Entitled: Combinations of potassium channel openers and sodium channel inhibitors or sodium channel-influencing active compounds for treating pains  
Valeant Pharmaceuticals North America a Corporation  
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☒ the assignee of the entire right, title, and interest; or  
2. ☐ an assignee of less than the entire right, title and interest.  
The extent (by percentage) of its ownership interest is \_\_\_\_\_ %

In the patent application/patent identified above by virtue of either:

- A. ☐ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

OR  
B. ☒ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

1. From: Inventors To: VIATRIS GMBH & CO. KG  
The document was recorded in the United States Patent and Trademark Office at  
Reel 015119, Frame 0804, or for which a copy thereof is attached.
2. From: VIATRIS GMBH & CO. KG To: XCEL PHARMACEUTICALS, INC.  
The document was recorded in the United States Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.
3. From: XCEL PHARMACEUTICALS, INC. To: VALEANT PHARMACEUTICALS NORTH AMERICA  
The document was recorded in the United States Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

- ☒ Copies of assignments or other documents in the chain of title are attached.  
[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

Robert Chris-Om  
Signature  
Printed or Typed Name

Vice President, Assistant Secretary  
Title

Feb. 17 2006  
Date

703-545-0100  
Telephone Number

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to the (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. There will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.